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Blair B.A. Birmingham

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EXAMINER

BELIVEAU, SCOTT E

ART UNIT

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2623

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/039,436	Applicant(s) BIRMINGHAM, BLAIR B.A.	
	Examiner Scott Beliveau	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-25, 27-39, 41-54 and 56-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-25, 27-39, 41-54 and 56-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1, 16, 28, and 42 have been considered but are moot in view of the new ground(s) of rejection.

With respect to applicant's arguments that the rejection of claims 42-54 and 56 are statutory, the examiner respectfully disagrees. While applicant notes an embodiment in which the claims are statutory in at least while resident within a given machine prior to transmission, the scope of the claims do not negate that a remote computer is simply downloading/processing an electromagnetic signal. Therefore, the scope of the 'computer readable medium', in light of the specification, includes the downloaded or electromagnetic signal.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 42-54 and 56 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 42 sets forth a "computer readable medium . . including instructions to manipulate a processor".

The instant application discloses that a 'computer readable medium' may be a signal (IA: Page 18, Line 25 – Page 19, Line 6). Specifically, the specification states that "the transmitted signal could be a signal . . . propagated through an air medium . . . such a signal may be a composite signal comprising a carrier signal, and contained within the carrier signal

is the desired information containing at least one computer program instruction implementing the invention . . . one skilled in the art would appreciate that the . . . transfer of the sets of instructions . . . changes the medium upon which it is stored . . . so that the medium carries computer readable information". Therefore, the scope of a 'computer readable medium including instructions to manipulate a processor' includes an electromagnetic signal. A claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in § 101.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 16-21 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Begeja et al. (US Pub No. 2003/0163815 A1).

Claim 16 is rejected wherein the Begeja et al. reference discloses a "method" as claimed. In particular, the 'method' involves "locating a keyword within a set of text representative of stored video content, the stored video content stored at a server" [205] (Para. [0046]), "selecting a first portion of the stored video content based on the location of the keyword with the set of text" (Para. [0049]) and "providing content associated with the first portion of

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the stored video content to a remote device based on a set of user-specific parameters” or designated keywords (Para. [0048] and [0062] – [0068]).

Claim 17 is rejected wherein the “set of text is representative of a closed captioning content of the stored video content” (Para. [0043]).

Claim 18 is rejected wherein the “keyword includes one of: a single word, a plurality of words, and a phrase” (Figure 4; Para. [0064]).

Claim 19 is rejected wherein the method further comprises “obtaining the keyword” (Figure 4; Para. [0062] and [0064]).

Claim 20 is rejected wherein the “keyword is specified by a user” (Figure 4; Para. [0063] and [0064]).

Claim 21 is rejected wherein the “user specifies the keyword using a website” (Para. [0072]).

Claim 27 is rejected wherein the “remote device includes one of: an alphanumeric pager, a two-way pager, a wireless telephone, and a hand-held computing device” (Para. [0057]).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Begeja et al. (US Pub No. 2003/0163815 A1) in view of Boies et al. (US Pub No. 2002/0194011 A1).

In consideration of claim 22, the Begeja et al. reference discloses a “method” as claimed. In particular, the ‘method’ involves “locating a keyword within a set of text representative of stored video content, the stored video content stored at a server” [205] (Para. [0046]), “selecting a first portion of the stored video content based on the location of the keyword with the set of text” (Para. [0049]) and “providing content associated with the first portion of the stored video content to a remote device” (Para. [0048] and [0062] – [0068]). While the reference discloses that ‘the content should be provided as a text transcript’ (Figure 5; Para. [0090]), the reference is unclear that it is necessarily provided ‘based on a set of user-specific parameters . . . includ[ing] a parameter indicating that the content should be provided as a text transcript’. In an analogous art pertaining to the processing of television content, the Boies et al. reference discloses ‘providing content . . . to [a] remote device based on a set of user-specific parameters . . . includ[ing] a parameter indicating that the content should be provided as a text transcript’ (Para. [0036]). According, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Begeja et al. so as to “providing content associated with a first portion of the stored video content to the remote device based on a set of user-specific parameters wherein the set of user specific parameters includes a parameter indicating that the content should be provided as a text transcript” for the purpose of providing a automatic way to provide information content in a format that is comprehensible by the individual receiving it (Boies et al.: Para. [0008]).

In consideration of claim 23, the Begeja et al. reference discloses a “method” as claimed. In particular, the ‘method’ involves “locating a keyword within a set of text representative of stored video content, the stored video content stored at a server” [205] (Para. [0046]),

“selecting a first portion of the stored video content based on the location of the keyword with the set of text” (Para. [0049]) and “providing content associated with the first portion of the stored video content to a remote device” (Para. [0048] and [0062] – [0068]). While the reference discloses that ‘the content should be provided as a still image representative of the first portion of the stored video content’ (Figure 5; Para. [0090]), the reference is unclear that it is necessarily provided ‘based on a set of user-specific parameters . . . includ[ing] a parameter indicating that the content should be provided as a still image representative of the first portion of the stored video content’. In an analogous art pertaining to the processing of television content, the Boies et al. reference discloses ‘providing content . . . to [a] remote device based on a set of user-specific parameters . . . includ[ing] a parameter indicating that the content should be provided as a still image” or graphic (Para. [0036]). According, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Begeja et al. so as to “providing content associated with a first portion of the stored video content to the remote device based on a set of user-specific parameters wherein the set of user specific parameters includes a parameter indicating that the content should be provided as a still image representative of the first portion of the stored video content” for the purpose of providing a automatic way to provide information content in a format that is comprehensible by the individual receiving it (Boies et al.: Para. [0008]).

In consideration of claim 23, the Begeja et al. reference discloses a “method” as claimed. In particular, the ‘method’ involves “locating a keyword within a set of text representative of stored video content, the stored video content stored at a server” [205] (Para. [0046]), “selecting a first portion of the stored video content based on the location of the keyword

with the set of text” (Para. [0049]) and “providing content associated with the first portion of the stored video content to a remote device” (Para. [0048] and [0062] – [0068]). While the reference discloses that ‘the content should be provided as an audio clip representative of the first portion of the stored video content’ (Figure 5; Para. [0090]), the reference is unclear that it is necessarily provided ‘based on a set of user-specific parameters . . . includ[ing] a parameter indicating that the content should be provided as an audio clip representative of the first portion of the stored video content’. In an analogous art pertaining to the processing of television content, the Boies et al. reference discloses ‘providing content . . . to [a] remote device based on a set of user-specific parameters . . . includ[ing] a parameter indicating that the content should be provided as an audio clip” or graphic (Para. [0036]). According, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Begeja et al. so as to “providing content associated with a first portion of the stored video content to the remote device based on a set of user-specific parameters wherein the set of user specific parameters includes a parameter indicating that the content should be provided as an audio clip representative of the first portion of the stored video content” for the purpose of providing a automatic way to provide information content in a format that is comprehensible by the individual receiving it (Boies et al.: Para. [0008]).

In consideration of claim 25, the Begeja et al. reference discloses a “method” as claimed. In particular, the ‘method’ involves “locating a keyword within a set of text representative of stored video content, the stored video content stored at a server” [205] (Para. [0046]), “selecting a first portion of the stored video content based on the location of the keyword with the set of text” (Para. [0049]) and “providing content associated with the first portion of

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the stored video content to a remote device” (Para. [0048] and [0062] – [0068]). While the reference discloses that ‘the content should be provided as a video clip representative of the first portion of the stored video content’ (Figure 5; Para. [0090]), the reference is unclear that it is necessarily provided ‘based on a set of user-specific parameters . . . includ[ing] a parameter indicating that the content should be provided as a video clip representative of the first portion of the stored video content’. In an analogous art pertaining to the processing of television content, the Boies et al. reference discloses ‘providing content . . . to [a] remote device based on a set of user-specific parameters . . . includ[ing] a parameter indicating that the content should be provided as a video clip” or graphic (Para. [0036]). According, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Begeja et al. so as to “providing content associated with a first portion of the stored video content to the remote device based on a set of user-specific parameters wherein the set of user specific parameters includes a parameter indicating that the content should be provided as a video clip representative of the first portion of the stored video content” for the purpose of providing a automatic way to provide information content in a format that is comprehensible by the individual receiving it (Boies et al.: Para. [0008]).

8. Claims 1-13, 15, 28-39, 41, 41-54 and 56-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Begeja et al. (US Pub No. 2003/0163815 A1) in view of Tracton et al. (US Pat No. 6,470,378 B1).

Claim 1 is rejected wherein the Begeja et al. reference discloses a “method” as claimed. In particular, the ‘method’ involves “accessing stored video content stored at a server” [205] (Para. [0046]), “identifying a first portion of the stored video content based on the closed

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captioning content and based on a bandwidth capability” (Para. [0049] and [0090]) and “providing content associated with the first portion of the stored video content to a remote device” (Para. [0048] and [0062] – [0068]).

While Begeja et al. teaches ‘identifying a first portion of the stored video content . . . based on a bandwidth capability’ (i.e. identifying particular frames, text, etc.), the reference is unclear with respect to the identification being based on a “bandwidth capability of a remote device” per se. In an analogous art related to the processing of television content, the Tracton et al. reference discloses determining a “bandwidth capability of a remote device” (Col 5, Lines 47-65) whereupon the system converts the data into a ‘suitable format’ based upon the client capabilities (Col 7, Lines 35-51). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Begeja et al. to “identifying a first portion of the stored video content based on the closed captioning content and based on a bandwidth capability of a remote device” for the purpose of providing a means to tailor the output of a remote server to tailor its output so as to meet the capabilities of each incoming client (Tracton et al.: Col 3, Lines 1-6).

Claim 28 is rejected wherein Figure 2 illustrates a “system” as claimed. The system comprises a “closed captioning decoder to decode a closed captioning content of stored video content to generate a set of text representative of closed captioning content” [205], a “content server to select a first portion of the stored video content based on an analysis of said text” [225] and a “transmitter to transmit content associated with said first portion of the stored video content to the remote device” [220] (Para. [0048] and [0062] – [0068]).

While Begeja et al. teaches 'selecting a first portion of the stored video content . . . based on a bandwidth capability' (i.e. identifying particular frames, text, etc.), the reference is unclear with respect to the identification being based on a "bandwidth capability of a remote device" per se. In an analogous art related to the processing of television content, the Tracton et al. reference discloses determining a "bandwidth capability of a remote device" (Col 5, Lines 47-65) whereupon the system converts the data into a 'suitable format' based upon the client capabilities (Col 7, Lines 35-51). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Begeja et al. "content server" [225] to "select a first portion of the stored video content based on an analysis of said text and based on a bandwidth capability of a remote device" for the purpose of providing a means to tailor the output of a remote server to tailor its output so as to meet the capabilities of each incoming client (Tracton et al.: Col 3, Lines 1-6).

Claim 42 is rejected as described in the rejection of claim 1 which is performed using a "computer readable medium . . . including instructions to manipulate a processor" in association with the implementation of the software architecture illustrated in Figure 2 of Begeja et al.

Claims 2, 29, and 43 is rejected wherein the "identifying a first portion includes: searching the closed captioning content for a keyword; and selecting the first portion of the stored video content based on a location of the keyword within the closed captioning text" such that the "analysis of said set of text includes locating a keyword within said set of text" (Begeja et al: Para. [0049]).

Claims 3, 30, and 44 are rejected wherein the “keyword is indicated by a user” (Begeja et al: Figure 4; Para. [0064]).

Claims 4, 31, and 45 are rejected wherein the “keyword includes one of: a single word, a plurality of words, and a phrase” (Begeja et al: Figure 4; Para. [0064]).

Claims 5, 32, and 46 are rejected wherein the “identifying a first portion includes: obtaining a set of parameters [including the bandwidth capability]; and selecting the first portion of the stored video content based on the set of parameters” such that the “analysis of said set of text includes selecting said first portion of the stored video content based on a set of parameters” (Tracton et al.: Col 5, Lines 47-65; Begeja et al: Para. [0049] and [0062] – [0064]).

Claims 6 and 47 are rejected wherein the “set of parameters includes at least one keyword” [410] (Begeja et al: Figure 4; Para. [0062] and [0064]).

Claims 7, 33, and 48 are rejected wherein the “set of parameters include parameters specifying a specific time period on a specific channel” (Begeja et al: Para. [0062], [0063], [0073], and [0084]).

Claims 8, 34, and 49 are rejected wherein the “set of parameters is specified by a user” (Begeja et al: Para. [0063] and [0064]).

Claims 9, 35, and 50 are rejected wherein the “set of parameters is specified by the user through a website” (Begeja et al: Para. [0072]).

Claims 10, 36, and 51 are rejected wherein the “content associated with the first portion includes a text transcript based on the closed captioning content” (Figure 5; Para. [0090]).

Claims 11, 37, and 52 are rejected wherein the “content associated with the first portion includes a still image representative of the first portion of the stored video content” (Begeja et al: Figure 5; Para. [0090]).

Claims 12, 38, and 53 are rejected wherein the “content associated with the first portion includes an audio clip representative of the first portion of the stored video content” (Begeja et al: Figure 5; Para. [0090]).

Claims 13, 39, and 54 are rejected wherein the “content associated with the first portion includes an video clip representative of the first portion of the stored video content” (Begeja et al: Figure 5; Para. [0090]).

Claims 15, 41 and 56 are rejected wherein the “remote device includes one of: an alphanumeric pager, a two-way pager, a wireless telephone, and a hand-held computing device” (Begeja et al: Para. [0057]).

Claim 57 is rejected wherein “providing content associated with the first portion of the stored video content comprises providing content in a format . . . based on a device type of the remote device” (Tracton et al.: Col 5, Lines 46-57; Col 7, Line 63 – Col 8, Line 28).

Claim 58 is rejected wherein “providing content associated with the first portion of the stored video content comprises providing content in a format . . . based on a set of user-specific parameters” namely those parameters specific to the user’s particular remote device (Tracton et al.: Col 5, Line 35 – Col 8, Line 5).

In consideration of claim 59, as aforementioned, while Begeja et al. teaches ‘selecting a first portion of the stored video content . . . based on a bandwidth capability’ (i.e. identifying particular frames, text, etc.), the reference is unclear with respect to the identification being

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based on a “bandwidth capability of a remote device” per se. In an analogous art related to the processing of television content, the Tracton et al. reference discloses determining a “bandwidth capability of a remote device” (Col 5, Lines 47-65) whereupon the system converts the data into a ‘suitable format’ based upon the client capabilities (Col 7, Lines 35-51). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Begeja et al. such that “selecting a first portion of the stored video content comprises selecting the first portion of the stored content based on a bandwidth capability of a remote device” for the purpose of providing a means to tailor the output of a remote server to tailor its output so as to meet the capabilities of each incoming client (Tracton et al.: Col 3, Lines 1-6).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343.

The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Scott Beliveau
Primary Examiner
Art Unit 2623

SEB
July 2, 2007